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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,459	10/18/1999	DENNIS G. PRIDDY	11104.2	2836

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EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/420,459	Applicant(s) PRIDDY, DENNIS G.	
	Examiner LUONG T. NGUYEN	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-8,14,23,24 and 26-29 is/are allowed.
- 6) ☒ Claim(s) 2,9-13,15,16 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/2005 has been entered.

Election/Restrictions

2. Applicant's election without traverse of Group I invention, claims 1-16, in the reply filed on 5/12/2004 is acknowledged.

3. Claims 17-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 5/12/2004.

Response to Arguments

4. Applicant's arguments with respect to claims 9-13, filed on 9/16/2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 15-16, filed on 9/16/2005 have been considered but are moot in view of the new ground(s) of rejection.

In re page 12, Applicant argues that Glass neither discloses nor suggests a communications node comprising means for receiving a transmission incorporating data element identifiers and containing an automatic identification indicia determined from a digital representation of a biometric attribute of a remote user and distinct from said digital representation. As explained in Applicant's specification, such an automatic identification indicia is obtained by processing the captured digital image, see specification at page 10, and thus is not a captured digital image or a cropped or compressed portion.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an automatic identification indicia is obtained by processing the captured digital image, see specification at page 10) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Instead, the Applicant amended claim 9 with limitation "a communications node comprising means for receiving a transmission incorporating data element identifiers and containing an automatic identification indicia associated with a remote user, said automatic identification indicia being determined from a digital representation of a biometric attribute of said remote user and distinct from said digital representation." The Examiner considers that claim 9 as amended still does not distinguish from Glass. Glass et al. discloses a communications node (authentication server 10, figure 2, column 4, line 45 – column 5, line 11) comprising means for receiving a transmission incorporating data element identifiers and containing an automatic identification indicia (a code corresponds to a digital representation of

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the image, column 3, lines 45-59, column 5, lines 4-6, 55-60) associated with a remote user (authentication server 10 receives biometric image file from client system 1 via communication network 9, figure 2, column 4, line 45 – column 5, line 11; it is noted that the biometric image file is digitized, column 4, lines 58-65), said automatic identification indicia being determined from a digital representation of a biometric attribute of said remote user and distinct from said digital representation (column 3, lines 45-59, column 5, lines 4-6, 55-60; note that the code is different from digital representation of the image).

In re page 13, Applicant argues that there is no motivation to combine Glass and Alperovich.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applying the teaching of Alperovich to the device of Glass allows a user to view a scene at a remote location.

In re page 13, Applicant argues that the combination Glass and Alperovich is impermissible hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Objections

5. Claims 5, 9, 12, 14-15, 23, 25-27, 29 are objected to because of the following informalities:

Claim 5 (line 20), "the multifunction" should be changed to --the multi-function--.

Claim 9 (line 6), "said user" should be changed to --said remote user--.

Claim 12 (line 3), "the original digital image" should be changed to --an original digital image--.

Claim 14 (line 13), claim 15 (line 5), "a biometric attribute" should be changed to --the biometric attribute--.

Claim 15 (line 3), "a sensor" should be changed to --a biometric sensor--, since claim 15 (lines 4 and 5) both recite limitation "said biometric sensor."

Claim 23 (lines 1-2), claim 27 (lines 1-2), "the real time automatic identification circuit" should be changed to --the automatic identification circuit--.

Claim 25 (lines 3), "the digitized image" should be changed to --a digitized image--.

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Claim 14 recites limitation “a wireless communications system.” Therefore, claim 26 (line 1), “the wireless communication system of claim 25” should be changed to --the wireless communications system of claim 14--. And claim 29 (line 1), “the wireless communication system of claim 15” should be changed to --the wireless communications system of claim 14--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 (line 1) recites the limitation "the" in “the means for inputting”.

Claim 2 (lines 4 and 6) recites the limitation “the” in “the first automatic identification indicia.” It should be noted that claim 1 (lines 9-10) recites limitation “an automatic identification indicia,” and claim 1 (line 16) recites limitation “an automatic identification information.”

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 9-12, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Glass et al. (US 6,332,193).

Regarding claim 9, Glass et al. discloses a communications node (authentication server 10, figure 2, column 4, line 45 – column 5, line 11) comprising means for receiving a transmission incorporating data element identifiers and containing an automatic identification indicia (a code corresponds to a digital representation of the image, column 3, lines 45-59, column 5, lines 4-6, 55-60) associated with a remote user (authentication server 10 receives biometric image file from client system 1 via communication network 9, figure 2, column 4, line 45 – column 5, line 11; it is noted that the biometric image file is digitized, column 4, lines 58-65), said automatic identification indicia being determined from a digital representation of a biometric attribute of said remote user and distinct from said digital representation (column 3, lines 45-59, column 5, lines 4-6, 55-60; note that the code is different from digital representation of the image), and means for identifying said user in response to said received automatic identification indicia (matcher for verifying the identity of the user, figure 2, column 3, lines 55-59).

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Regarding claim 10, Glass et al. discloses a database comprising a plurality of securely stored automatic identification indicia corresponding to a plurality of remote users (more authentication servers connected to the network, column 4, lines 14-18).

Regarding claim 11, Glass et al. discloses means for verifying the identity and authenticity of the remote user associated with said received automatic identification indicia (matcher for verifying the identity of the user, figure 2, column 3, lines 55-59), wherein the transmission is associated with said remote user conducting a financial transaction (column 3, lines 36-42) and said transmission includes remote user credit or debit account information (inherently included in performing online banking transaction, column 8, lines 22-35).

Regarding claim 12, Glass et al. discloses the transmission includes data corresponding to a digital image (column 4, lines 58-60), means for storing the received digital data corresponding to the original digital image (frame store 43, figure 3, column 5, lines 54-56).

Regarding claim 25, Glass et al. discloses the means for receiving a non-biometric automatic identification indicia determined from information coded within the digitized image (the digital signature can be sent to the authentication server, figure 2, column 6, lines 50-55).

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hsu

(EP 0924657).

Regarding claim 15, Hsu discloses a portable wireless communications device (cellular phone 14', figure 1A, paragraphs [0018], [0020], [0021]) comprising a multi-function integrated semiconductor device having integrated in a single integrated circuit (inherently included in cellular phone 14') a personal database secure to all but a specified user (a reference fingerprint image stored in the device 14'; note that when the user places a finger over the sensor 16 and actuates a switch, the person's fingerprint is scanned and compared with a reference fingerprint image stored in the device 14'. If there is a match, the device 14' transmits a confirming message to the door 10, and the door 10 is opened, figure 1A, paragraphs [0020], [0021]); a sensor responsive to a biometric attribute (biometric sensor 16, figure 1A, paragraph [0018]), and a processor (processor module 20, figure 2, paragraphs [0020] - [0023]) responsive to said biometric sensor and said secure personal database for verifying a sensed biometric attribute sent by said biometric sensor, and granting access to said personal database on biometric verification (when the user places a finger over the sensor 16 and actuates a switch, the person's fingerprint is scanned and compared with a reference fingerprint image stored in the device 14'. If there is a match, the device 14' transmits a confirming message to the door 10, and the door 10 is opened, figure 1A, paragraphs [0020], [0021]).

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Regarding claim 16, Hsu discloses means for transmitting (cellular phone 14' includes a transmitter to communicate with communication network 17, figure 1A, paragraph [0019]) to a remote location a copy of said sensed biometric attribute in response to a failure to verify said biometric attribute

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glass et al. (US 6,332,193) in view of Alperovich et al. (US 6,317,609).

Regarding claim 13, Glass et al. fail to specifically disclose means for downloading to a plurality of remote display devices, said stored data corresponding to a digital image, said remote display devices being selected from among the group consisting of portable wireless communication devices, personal computers, and cable connected television sets. However, Alperovich et al. disclose a system and method for transporting digital speech and digital pictures, in which the digital image 355 from mobile station MS 20a is transmitted and displayed at MS 20b (figures 3-4, column 3, lines 1-10, column 6, lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Glass et al. by the teaching of Alperovich et al. in order to allow a user to view a scene at a remote location.

Allowable Subject Matter

14. Claims 1, 3-8, 14, 23-24, 26-29 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, the prior art of the record fails to show or fairly suggest a multi-function integrated semiconductor device comprising a single integrated circuit containing an automatic identification circuit within the real-time image processing circuit, responsive to a captured image, to generate an automatic identification indicia of a biometric attribute from a digitized image of said biometric attribute, in combination with other claim elements.

Claims 3-8, 23-24 are allowable for the reasons given in claim 1.

Regarding claim 14, the prior art of the record fails to show or fairly suggest wireless communications system comprising a multi-function integrated semiconductor device comprising a single integrated circuit having an automatic identification circuit within the real-time image processing circuit, responsive to a captured image, to generate an automatic identification indicia of a biometric attribute from a digitized image of said biometric attribute, in combination with other claim elements.

Claims 26-29 are allowable for the reasons given in claim 14.

15. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T. NGUYEN whose telephone number is (571) 272-7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NGOCYEN VU can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN
12/11/05



**LUONG T. NGUYEN
PATENT EXAMINER**